

REMARKS/ARGUMENTS

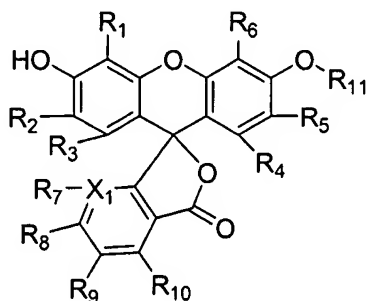
Claims 1-17 are currently pending.

Claim Rejections Under 35 U.S.C. § 102(b)-- Anticipation

Claims 1–17 have been rejected under 35 U.S.C. § 102(b) as being anticipated by JP 62-288828 ("Harada *et al.*"), in light of its English language abstract. In support of the rejection the Examiner alleges that Harada *et al.*, based upon a spot translation by a PTO staff member, discloses a silver halide polymerizable photographic material comprising cyan, magenta, and yellow coloring layers, wherein the layers comprise a leuco dye meeting the instant claim limitations for both the properties and structure. The Applicants traverse this ground of rejection as structures I and II in Harada *et al.*, referred to in the Abstract, do not teach each and every structural limitation of the compounds of the claims 1–17 of the instant application.

Claims 1 and 2–6

Referring to claim 1 (of the instant application), upon which claims 2–6 depend, is drawn to fluorescein compounds represented by the structural formula I:



(I)

In structure (I), the benzene ring bearing substituents R₁, R₂ and R₃ is specifically shown as bearing a hydroxyl (OH) group (at position 3 of the fluorescein nucleus). The benzene ring

bearing substituents R₄, R₅ and R₆ is shown as bearing a substituent -OR₁₁ (at position 6 of the fluorescein nucleus). Substituent R₁₁ is defined as follows in Applicants' Claim 1:

"R₁₁ is selected from the group consisting of alkyl, substituted alkyl, alkenyl, substituted alkenyl, alkynyl, substituted alkynyl, heterocycloalkyl, substituted heterocycloalkyl, substituted carbonyl, acylamino, sulfonyl, aryl, substituted aryl, heteroaryl and substituted heteroaryl." Note that R₁₁ cannot be a hydrogen atom, and therefore that the -OH and -OR₁₁ substituents at positions 3 and 6 of the fluorescein nucleus of applicants' structure (I) are necessarily different from each other. The -OH and -OR₁₁ substituents at positions 3 and 6 of the fluorescein nucleus in Applicants' structure (I) correspond to substituents OR₁ and OR₂ of structures I and II of Harada *et al.*

The English language Abstract of Harada *et al.* defines substituents OR₁ and OR₂ of structures I and II as follows (*italics and underline added*):

"In formula, A denotes -O-, etc., R denotes a substituent of a positive substituent constant sigma, R<1>, R<2> denote an alkyl group, etc., R<3> and R<4> denote an alkoxy group, etc., and n is 1 or 2. " There is no suggestion in this abstract that one of R₁ and R₂ can be a hydrogen atom, and the other a group meeting the claimed limitations of R₁₁ in Applicants' structure (I). The phrase "an alkyl group, etc." does not specify, or even necessarily include, a hydrogen atom. Moreover, in the entire disclosure of Harada *et al.* there is no example of a molecule in which one of R₁ and R₂ in structures I or II is a hydrogen atom and the other an alkyl group (or other group meeting the claimed limitations of R₁₁ in Applicants' structure (I)).

The United States Patent No. 4,803,148 derives from the disclosure of JP 62-288828. The abstract of United States Patent No. 4,803,148 defines substituents R₁ and R₂ as follows (*italics and underline added*):

"ABSTRACT

A light-sensitive material comprising a light-sensitive layer containing silver halide, a reducing agent, a polymerizable compound and a leuco dye provided on a support, characterized in that the leuco dye is a compound having the following formula (I): ##STR1## in which A is --O-- or ##STR2## and R is a substituent having a positive substituent constant (σ); one of X and Y is nitrogen and the other is carbon; each of R₁ and R₂ is an alkyl group, a cycloalkyl group or an

aralkyl group; each of R₃ and R₄ is an alkyl group, an alkoxy group, a cycloalkyl group, an aralkyl group or an aryloxy group; each of l, m and n is 1 or 2."

There is no suggestion in this abstract that one of R₁ and R₂ can be a hydrogen atom, and the other a group meeting the claimed limitations of R₁₁ in Applicants' structure (I). Accordingly, the Applicants respectfully submit that claims 1 and 2-6 are not anticipated by Harada *et al.* as the cited reference does not teach every limitation of the compounds of claims 1 and 2-6 of the instant application.

Claims 7-17

Claims 7-17 of the present application are drawn to a color imaging member. Harada *et al.* does not teach each and every limitation of the imaging member recited in claims 8-17 of the instant application. Claim 7 and claims 8-17 which depend therefrom are drawn to "a color imaging member comprising a first image-forming layer including a compound according to Claim 1, said compound being in the crystalline form." [emphasis added]. There is no suggestion in Harada *et al.* that the leuco dyes of structures I or II should be in the crystalline form. Indeed, it is stated in United States Patent No. 4,803,148 (see column 26, line 35) that the leuco dye is dissolved in trimethylolpropane triacrylate in order to prepare the light-sensitive composition. The dissolution of the leuco dye specifically excludes the possibility the compound(s) could be used in the crystalline form. Accordingly, the Applicants respectfully submit that claims 7-17 are not anticipated by Harada *et al.* as the cited reference does not teach every limitation of the compounds of claims 7-17 of the instant application.

For the reasons stated above, the Applicants respectfully request reconsideration and withdrawal of the rejections of claims 1-17 pursuant to 35 U.S.C. § 102(b). The Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

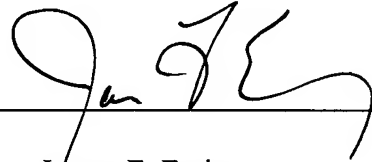
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date January 9, 2007

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By

A handwritten signature in black ink, appearing to read 'J. Ewing', is written over a horizontal line.

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